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PATENT
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Attorney Docket No. 05725.1013-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Sophie Hélène VAYRETTE) Group Art Unit: 3732
)
Application No.: 10/043,342) Examiner: A. Ramana
)
Filed: January 14, 2002)
)
For: DEVICE FOR CLEANSING THE)
BODY)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Office Action mailed June 16, 2004, Applicant respectfully requests that the Examiner reconsider the present application, join and examine claims 90-95 on the merits, and withdraw the claim rejections for the reasons explained in detail below.

As an initial matter, Applicant would like to thank Examiners Ramana and Robert for the courtesy and consideration extended to Applicant's representative during the personal interview conducted on September 1, 2004. During the interview, the following issues were discussed.

Withdrawal of Claims 90-95

In the Office Action dated June 16, 2004, the Examiner did not rejoin claims 90-95 and provide examination of those claims on the merits apparently because the Examiner continues to believe that claims 90-95 "are not generic." Applicant

respectfully submits, however, that claims 90-95, which were added by Applicant's Amendment filed October 6, 2003, "read on" Fig. 4 of elected Species VII, which was elected in the Response to Election of Species Requirement filed on April 18, 2003.

In the Office Action, the Examiner asserts that "claims 90-95 are directed to the non-elected species II (Fig. 2), an envelope with two independent thumb portions located at opposite lateral ends of the envelope," that "[w]hen a species II envelope is worn on a hand, one thumb portion is always unused," and further that "the envelope of Fig. 4 (elected species VII) has four finger portions, one for each finger of one hand, and one thumb portion so that when such an envelope is worn, all finger portions and the thumb portion are occupied." Office Action at 2. In other words, the Examiner apparently believes that the envelope shown in Fig. 2, must necessarily be worn on a user's hand in a manner such that one of the thumb portions is not occupied by either a thumb or a non-thumb finger. The Examiner also apparently believes that the envelope shown in elected Fig. 4 must necessarily be worn on a user's hand in a manner such that all five of the digit-receiving portions are occupied by either a thumb or a non-thumb finger. The Examiner apparently believes that these assertions necessarily exclude the possibility that Fig. 4 depicts an "envelope . . . configured to have two independent thumb portions located at opposite lateral ends of the envelope," as recited in independent claims 90 and 93.

Applicant respectfully submits that regardless of the Examiner's above-outlined assertions, claims 90-95 read on Fig. 4 of elected Species VII at least because no portion of the envelope shown in Fig. 4 or the description of Fig. 4 excludes the possibility that Fig. 4 depicts an "envelope . . . configured to have two independent thumb portions located at opposite lateral ends of the envelope," as recited in

independent claims 90 and 93. First, Applicant respectfully disagrees with the Examiner's assertion that "[w]hen a species II envelope is worn on a hand, one thumb portion is always unused," at least because there is a possibility that a user may insert a finger in the thumb portion located opposite the thumb portion in which the user places their thumb in the envelope depicted in Fig. 2. Second, Applicant respectfully disagrees with the Examiner's assertion that "the envelope of Fig. 4 (elected species VII) has four finger portions, one for each finger of one hand, and one thumb portion so that when such an envelope is worn, all finger portions and the thumb portion are occupied," at least because there is a possibility that not all of the "finger portions" will be occupied, for example, if the user is missing one or more fingers, or decides to bend one or more fingers across the user's palm rather than extending the one or more fingers into the digit-receiving portions located at opposite lateral ends of the Fig. 4 envelope. Because the Examiner's assertions about how the envelopes of Fig. 2 and Fig. 4 must necessarily be worn are not necessarily valid, Applicant respectfully submits that the examiner's belief that claims 90-95 do not read on Fig. 4 is not valid.

Furthermore, even if for the sake of argument the Examiner's assertions about how the envelopes shown in Figs. 2 and 4 may be worn are valid, those assertions do not negate the fact that claims 90-95 read on Fig. 4 at least because the envelope shown in Fig. 4 can be worn on either hand and/or on each hand in a different direction, such that a user's thumb can be inserted in either digit-receiving portion located on opposite lateral ends of the envelope shown in Fig. 4. Since either digit-receiving portion located at opposite lateral ends of the Fig. 4 envelope can receive a user's thumb, both of the digit-receiving portions can be reasonably characterized as "thumb portions," regardless of the fact that those same digit-receiving portions are also

capable of receiving non-thumb finger portions as well. In other words, the fact that the digit-receiving portions located at opposite lateral ends of the envelope can receive non-thumb fingers does not exclude the possibility that those same digit-receiving portions can also receive thumbs. In fact, each of the digit-receiving portions located at opposite lateral ends of the envelope shown in Fig. 4 are configured to receive thumb portions so that the Fig. 4 envelope can be worn on either hand and/or on one hand in either direction. Indeed, this configuration permits a user to easily place whichever lateral side of the envelope is desired on the palm side of the user's hand so as to be able to easily rub that side against a surface, for example, on the user's body. Therefore, Applicant respectfully submits that claims 90-95 read on Fig. 4. Accordingly, Applicant respectfully requests reconsideration of the Office Action's withdrawal of claims 90-95 from examination on the merits, and rejoinder and examination on the merits of those claims.

Claim Rejections

In the Office Action, claims 1-6, 13-15, 18-24, 26, 34-39, 48, 49, 60-65, 70-72, 75-79, 81, and 89 were rejected under 35 U.S.C. § 103(a) based on Street (U.S. Patent No. 6,017,351) in combination with Strong (U.S. Patent No. 5,636,406); and claims 1, 8, 10, 60, 67, and 69 were rejected under 35 U.S.C. § 103(a) based on Street in combination with Seunevel (U.S. Patent No. 3,602,917). Claims 1 and 60 are the only independent claims rejected under § 103(a) based on either Street combined with Strong or based on Street combined with Seunevel. Applicant respectfully traverses those rejections at least because there is no suggestion or motivation to combine the references in the hypothetical manner proposed in the Office Action.

The M.P.E.P. advises that in order to establish a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings.” § 2143. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” § 2143.01 (citation omitted) (emphasis in original). Because there is no suggestion or motivation to combine either the Street and Strong references or the Street and Seunevel references in the Office Action’s proposed hypothetical manner, the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicant’s independent claims 1 and 60 are patentably distinguishable from those references.

Applicant’s independent claims 1 and 60 each recite a device for treating a keratinous surface of a body including, among other recitations, an “envelope . . . configured as one of a glove and a mitten comprising at least one thumb portion.” In the Office Action, the rejection statement acknowledges that the Street reference does not disclose “either a glove or a mitten with at least one thumb portion.” Office Action at 3. The rejection statement, however, concludes that it would have been obvious “to have provided two thumb portions on the Street pad 100 . . . for ambidexterity,” apparently based on the rejection statement’s allegation that “Strong teaches a cosmetic pad 10 with either one or two thumb portions (Figures 2 and 3) wherein two opposed or independent thumb portions (i.e., a pad symmetric about a longitudinal axis) enable use of pad 10 on a human right or left hand (col. 2, lines 54-59).” Id.

Applicant respectfully disagrees with the rejection statement's conclusion about the obviousness of providing two thumb portions on the Street pad 100 based on the teachings of Strong. The Strong reference relates to a self-adhering lotion application pad 10 for adhesive attachment to a palmar side of a human hand, which covers the palm, fingers, and thumb to prevent contact between the hand and the lotion. The pad includes a flexible applicator pad body 15 having a lotion applicator surface 16 and an opposed adhesive surface 17. The pad 10 is generally shaped like a human hand, including a marginal edge surface 18 that defines a finger section 19, at least one thumb section 20, and a truncated palm section 21. An adhesive 24 is provided on the adhesive surface 17 for releasably securing the applicator pad 10 to the user's hand, covering the palmar sides of the fingers, thumb, and palm (see Fig. 2). A liner 26 is provided for covering the adhesive 24 until separation for contact with the user's hand. In one "preferred" form, the applicator pad 10 includes either one thumb section 20 (see Fig. 2) or "preferably" two opposed thumb sections 20 (see Fig. 3) positioned on opposite sides of the applicator pad body 15 to enable use of the pad 10 on either a right hand or a left hand. In one form, the thumb sections 26 are selectively separable (see Fig. 5) from the applicator pad body 15, by virtue of tear strips or perforations 25 provided through the pad body 15 between the opposed thumb sections 20 and palm section 21. Either of the thumb sections 20 may be removed by tearing the selected thumb section 20 along the tear strips or perforations 25. When thumb sections 20 are not removed, the user may attach the pad 10 to one hand and apply lotion with the pad 10 on that hand, and then remove the pad 10 from the one hand and apply it to the other hand to finish application.

Applicant respectfully disagrees with the Examiner's conclusion that it would have been obvious "to have provided two thumb portions on the Street pad 100 . . . for ambidexterity" at least because there is no suggestion or motivation to modify the Street reference in the Examiner's proposed hypothetical manner. For example, the Street reference discloses, referring to Fig. 12, "that a user can select and use either side [of the mitt 100] by rotating the inserted hand within the mitt 100 to select the appropriate cosmetic abrasive pad surface for scrubbing, to remove detritus or the like from the skin." Col. 9, lines 54-57. In other words, the Fig. 12 example of the Street mitt 100 is configured to allow the user to wear the mitt in either direction on a user's hand. Furthermore, since the mitt 100 is configured to be worn in either direction on the user's hand, it could also be worn on the user's other hand by virtue of its symmetrical shape. Therefore, there would be absolutely no reason to add two thumb portions to either side of the Street mitt 100 "for ambidexterity," as asserted by the rejection statement since the Street mitt 100 already provides "ambidexterity." Furthermore, if the Street mitt 100 were modified to include thumb portions as suggested by the rejection statement, it would impede the user's ability to rotate their inserted hand within Street's mitt 100, and thereby make it difficult to select use of either side of the mitt, which is an explicitly-mentioned feature of Street. For at least those reasons, there is no suggestion or motivation to modify the Street mitt 100 in the rejection statement's proposed hypothetical manner. Therefore, Applicant respectfully submits that the Office Action's proposed hypothetical combination of the Street and Strong references is improper under the guidance of the M.P.E.P.

Turning to the Office Action's § 103(a) rejection of claims 1, 8, 10, 60, 67, and 69 based on the Office Action's proposed hypothetical combination of the Street and

Seunevel references, the rejection statement concludes that “it would have been obvious . . . to have shaped [the Street] pad 10 in the form of a glove that may be worn on either hand since it was known in the art to provide such gloves to avoid discomfort to a wearer,” apparently based on the rejection statement’s allegation that the Seunevel reference discloses “a glove that may be worn on either hand of a user (Fig. [sic] 1-3 and 5, col. 1, lines 6-9 and col. 2, lines 65-68).” Office Action at 4.

Notwithstanding the rejection statement’s allegation about what the Seunevel reference discloses, Seunevel relates to a glove formed of synthetic resin or elastic material such as rubber, which may be worn on either hand “without discomfort.” The glove includes extensions in an area of a thumb on the palm side and back side, as well as a series of wide longitudinal undulations O_1 through O_{12} forming gussets oriented substantially along a direction intermediate between the longitudinal direction of the thumb and the direction of the longitudinal axis of the glove (see, i.e., Figs 1-3). For at least reasons similar to those outlined above with respect to the Office Action’s proposed hypothetical combination of the Street and Strong references, there is no suggestion or motivation to modify the Street mitt 100 in the rejection statement’s proposed hypothetical manner. Therefore, Applicant respectfully submits that the Office Action’s proposed hypothetical combination of the Street and Seunevel references is improper under the guidance of the M.P.E.P. Accordingly, Applicant’s independent claims 1 and 60 are each patentably distinguishable from either Street combined with Strong or Street combined with Seunevel.

Independent Claims 90 and 93

As outlined previously herein, independent claims 90 and 93 (and new dependent claims 91, 92, 94, and 95) read on the elected species of Fig. 4 and are generic to the species of Figs. 1, 2, and 4. Each of those independent claims recites a device for treating a keratinous surface of a body including an envelope "configured to have two independent thumb portions located at opposite lateral ends of the envelope." The Street, Strong, and Seunevel references, taken individually or in combination, fail to disclose or suggest at least that subject matter recited in independent claims 90 and 93. Therefore, independent claims 90 and 93, as well as dependent claims 91, 92, 94, and 95, are patentably distinguishable from those references.

In the Office Action, claims 16, 17, 25, 27-33, 40-47, 50-59, 73, 74, 80, and 82-88 were rejected under 35 U.S.C. § 103(a) based on Street and Strong in view of one or more of the following references: Snyder et al. (U.S. Patent No. 4,319,956); Ginger et al. (U.S. Patent No. 4,347,931); and Gruenbacher et al. (U.S. Patent No. 6,508,602). Since each of those claims depends from one of the above-mentioned independent claims, those dependent claims should be allowable for at least the same reasons as their corresponding independent claims.

Conclusions

For at least the reasons set forth above, independent claims 1, 60, 90, and 93 are allowable. Dependent claims 2-6, 8, 10, 13-59, 61-65, 67, 69-89, 91, 92, 94, and 95 depend from one of independent claims 1, 60, 90, and 93. Consequently, those dependent claims should be allowable for at least the same reasons the claims from which they depend are allowable.

Therefore, Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, and the allowance of claims 1-6, 8, 10, 13-65, and 70-95. In addition, since generic claims 1 and 60 are allowable, withdrawn dependent claims 7, 9, 11, 66, and 68 should be rejoined and also allowed.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned representative at (571) 203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 16, 2004

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